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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,458	08/23/2001	Robert G. Biskeborn	SJO9-2000-0201US1/IBM1P00	2228

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EXAMINER

MILLER, BRIAN E

ART UNIT PAPER NUMBER

2627

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,458

Applicant(s)

BISKEBORN ET AL.

Examiner

Brian E. Miller

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claims 1-36 are pending.

Election/Restrictions

1. Applicant's election without traverse of Group III, claims 27-36, in the reply filed on 3/2/06 is acknowledged.
2. Claims 1-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/2/06.

Drawings

3. The drawings are objected to because (a) in Figs. 10 & 11, reference numerals "1022", "1002" & "1102" appear to be drawn to the same area; similarly for reference numerals "1016", "1006" & "1100". It is suggested to use reference arrows to show a general area to differentiate from non-arrows. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet"

or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 30 & 36 are objected to because of the following informality: (a) the phrase “is equipped with” should be modified to “having a” for example, for better readability; (b) claim 36, after “comprising” the phrase “the steps of” should be inserted. Appropriate correction is required.

Specification

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

6. The abstract of the disclosure is objected to because it is not directed to the now claimed/elected invention. Correction is required. See MPEP § 608.01(b).

7. The disclosure is objected to because of the following informalities: on page 5 the under the heading of “Disclosure of the Invention” is simply a reiteration of the current Abstract and should be amended or omitted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 27-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (a) Claim 1, lines 14-15, the phrase “the second side face” lacks proper antecedent basis; (b) claim 28, line 7 the phrase “between the transducers” lacks proper antecedent basis, as only “at least one transducer” has been previously set forth in the claim; (c) claim 36, similarly, line 6 the phrase “at least one transducer” lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 28-33, 35-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Biskeborn et al (US 5,905,613). Biskeborn et al (with respect to claim 28) discloses a magnetic head, shown mainly in FIGs. 3-4, 9-11, comprising: (a) a head body with a substantially rectangular configuration including a top face 93, a bottom face, e.g. 76, a pair of elongated side faces (unnumbered but shown in FIG. 3), and a pair of short end faces (unnumbered but shown in FIG. 3); (b) at least one transducer (understood from “flat transducing surface” 79-col. 5, line 66) formed in communication with the top face of the head body; and (c) a single groove, e.g. 68 (FIG. 9), formed in the top face of the head body and extending between the at least one transducer and one of the side faces of the head body; (as per claim 29) further comprising a closure 90 coupled to a first one of the side faces, e.g., adjacent 91 (FIG. 11) of the head body

coincident with the top face thereof; (as per claim 30) wherein the closure 90 is equipped with a substantially rectangular configuration having a length substantially equal to the head body (see FIG. 3); (as per claim 31) wherein the groove 68 is defined by a first surface, e.g., 65, positioned in a plane substantially parallel with the side faces of the head body; (as per claim 32) wherein the first surface, e.g. 65, is defined by edges coincident with the top face and the end faces of the head body; (as per claim 33) wherein the groove, e.g. 68, is further defined by a second surface, e.g., identified as surface 68, positioned in a plane substantially parallel with the top and bottom faces of the head body (see FIG. 9); (as per claim 35) wherein the groove, e.g., 68, is adapted for providing a discontinuity edge and controlling an overwrap angle of a tape 95 sliding along the at least one transducer (see col. 6, lines 16-25 and FIG. 11).

As the “method” of claim 36 encompasses similar limitations as recited in claim 28, it is rejected under the same grounds.

Allowable Subject Matter

12. Claim 27 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

13. Claim 34 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Miller whose telephone number is (571) 272-7578. The examiner can normally be reached on M-TH 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brian E. Miller
Primary Examiner
Art Unit 2627

BEM
May 12, 2006